

REMARKS

Claims 1-37 were pending in the present application. Examiner has required Applicants to elect one of groups I - XXVIII in the Office Action. Accordingly, Applicants hereby provisionally elect, with traverse, Group IV, encompassing claims 1, 6, 27 and 31-36.

Applicants also choose, with traverse, N-[4-bromo-2-(1H-tetrazol-5-yl)phenyl]-7-{{4-(4-methoxyphenyl)butanoyl}amino}-1H-indole-2-carboxamide as the elected species. Applicants notes that claims 1, 6 and 31-37 read on the elected species.

TRAVERSAL

Applicant respectfully points out that the Office Action's requirement for restriction creates 28 separate invention groups out of only 37 claims. On average, that amounts to less than 2 claims per invention group. In reality, Office Action's requirement is even more burdensome, often requiring multiple restrictions from a single claim. Claim 1, for example, is restricted into 28 separate invention groups. In addition, the requirement to elect a single species would further multiply the number of potential applications.

In this regard, Applicant respectfully submits that examination of all pending claims 1-37 of the present application is far less burdensome for both Applicants and the Patent Office than would be prosecution of 28 or more separately filed applications as a result of Office Action's restriction and species election.

At a minimum, Applicant respectfully requests that Examiner consolidate the numerous groups having common classifications. Applicant respectfully submits that such consolidation will impose no serious burden on the Patent Office, nor has the Office Action alleged that such a burden exists as required under the rules.

A. Groups.

The Office Action's groups are as follows:

- (1) Groups I, IV, V, VI, VII, VIII, IX, XI, are classified in class 548; and
- (2) Group II is classified in class 546;
- (3) Groups III, X are classified in class 544;

- (4) Groups XII, XIII, classified in class 549; and
- (5) Groups XV, XVI, XVII, XVIII, XIX, XX, XXI, XXII, XXIII, XXIV, XXV, XXVI, XXVII are classified in class 514;
- (6) Group XIV, claims 1 and 27-36, drawn to products not embraced by Groups I-XIII; and
- (7) Group XXXVIII, claim 37, drawn to method of using products not embraced by Groups XV-XXVII.

B. Groups Sharing The Same Classification May Be Consolidated In Accordance With The Rules

The criteria for restriction is set forth in MPEP §803 as follows:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent or distinct; and

(B) There must be a serious burden on the examiner if restriction is required. (emphasis added) (internal citations omitted).

Concerning the second prong, § 803 instructs that examiners establish a “serious burden” by demonstrating one of three *prima facie* elements:

- (A) the inventions have a separate classification;
- (B) the inventions have a separate status in the art; or,
- (C) the inventions have a different field of search, as defined in MPEP § 808.02.

C. Examiner Does Not Allege That Examination Of Claims Sharing The Same Classification Would Impose A Serious Burden.

(i) Most claims have common classifications

The Office Action does not satisfy the *prima facie* case with respect to inventions identified as having separate classifications. In fact, claims of Groups I, IV, V, VI, VII, VIII, IX, and XI have the same classification, i.e. belonging to class 548. The Examiner passes no

judgment on whether examination of inventions with common classifications imposes a similar serious burden. Applicant respectfully submits there is none.

Rather, the Examiner alleges that the variously defined inventions are “independent” or “distinct” in satisfaction of only the first prong of this two prong test. However, M.P.E.P. § 803 makes it clear that independent or distinct inventions must still be examined collectively, i.e., not restricted, unless such examination would impose a serious burden on the examiner.

Groups I, IV, V, VI, VII, VIII, IX, XI, are classified in class 548. Accordingly, these groups do not satisfy the first *prima facie* element for a serious burden set forth under § 803.

(ii) **A separate status in the art is not alleged for groups sharing the same classification**

M.P.E.P. §803 makes it clear that Examiner may also demonstrate a serious burden where the inventions have acquired a separate status in the art. The Examiner did not make such an allegation. Accordingly, the Examiner’s rejection fails to satisfy the second *prima facie* element under § 803.

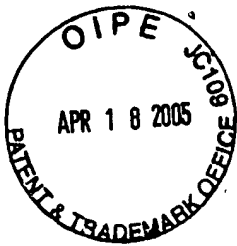
(iii) **Different Field of Search**

The third *prima facie* element specifies that the Examiner may demonstrate that the inventions require a “different field of search.” A different field of search is found where it is “necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists” (MPEP § 808.02). However, Examiner makes no allegation that a distinct field of search is required. Accordingly, the Examiner’s rejection also fails to satisfy the third and final *prima facie* element under M.P.E.P. § 803. None of the three factors of the *prima facie* case are satisfied with respect to inventions having common classifications. It cannot be maintained, therefore, that these inventions impose a serious burden.

D. Where There Is No Serious Burden Examination Of The Entire Case “Must” Occur

Here the MPEP is clear that:

If the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (MPEP § 803) (emphasis added).



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CONCLUSION

Accordingly, Applicant respectfully requests that Examiner reconsider and withdraw the present restriction requirement, and revise the restriction requirement according to the arguments and suggested groups presented above.

It is believed that no fee is required for the consideration of this Response. However, if any fees are required, the examiner is authorized to charge such fees to Deposit Account No. 16-1445.

Date:

04/14/05

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